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In re Application of WERNHAM et al. :
Application No.: 10/539,623 : DECISION ON PETITION
PCT No.: PCT/EP03/51068 :
Int. Filing: 18 December 2003 : UNDER 37 CFR 1.47(a)
Priority Date: 19 December 2002 :
Attorney Docket No.: 4590-418 :
For: AN OPTICAL FILTER :

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 18 January 2007, to accept the application without the signature of joint inventor, Denny Wernham.

BACKGROUND

On 14 February 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 14 September 2006, applicant filed a petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Denny Wernham alleging that Mr. Wernham refuses to sign the application.

On 01 December 2006, a decision dismissing the petition was mailed indicating that Petitioner had failed to demonstrate that the non-signing inventor refused to sign the application papers.

On 18 January 2007, a renewed petition under 37 CFR 1.47(a) was filed with the USPTO.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner previously satisfied Items (1), (3) and (4).

With respect to Item (2)¹ above, Petitioner provided a copy of a letter sent on 21 September 2005 to the nonsigning inventor Wernham from Ian D. Morgan, Contracts Manager for Thales Optics Limited. The letter indicates that a specification, claims, drawings, abstract and declaration/power of attorney were enclosed. However, this letter does not make reference to the US patent application 10/539,623, the application at issue. The email correspondence between the nonsigning inventor and Mr. Morgan does not identify US patent application 10/539,623 at issue. It is unclear from the evidence presented that it is this application 10/539,623 which inventor Wernham is refusing to sign. Mr. Morgan's first hand statement regarding this correspondence has not been submitted and is required. See MPEP §409.03(d) in footnote 1.

The declaration of Pascale Brochard, previously provided in support of the petition under 37 CFR 1.47(a), indicates that Mr. Wernham refuses to sign the "Request" relating to PCT/EP03/51068. It does not state that Mr. Wernham refuses to sign US patent application

¹ Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

10/539,623.

At this time, there is no evidence that a complete copy of US application 10/539,623 (including specification, claims and drawings and declaration) were provided to Mr. Wernham. Petitioner has not provided a first hand statement indicating that a complete copy of the application US 10/539,623 was sent to the inventor for his signature and that Mr. Wernham refuses to it. What is required is that Mr. Wernham be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) *for this application*.

In sum, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/539,623 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Wernham's refusal to sign, either in writing or by telephone, these documents.

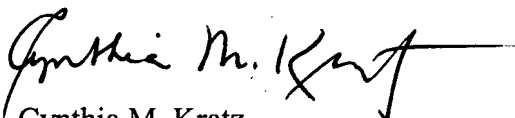
For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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